REMARKS

In the Final Office Action,[1] the Examiner took the following actions:

(1)   provisionally rejected claims 1, 3, 6, 7, 12, 14, 16, 18 on the ground of

non-statutory obviousness-type double patenting over claims 6, 10, 12, and 14 of

copending Application No. 10/658,684 ('684 application);

(2)   rejected claims 1, 3-8, 10-12, 14-16, 18, and 19 under 35 U.S.C. § 102(e) as

being anticipated by U.S. Patent No. 7,007,278 to Gungabeesoon

("*Gungabeesoon*"); and

(3)   rejected claims 2, 9, 13, and 17 under 35 U.S.C. § 103(a) as being unpatentable

over *Gungabeesoon* in view of "Database Performance in the Real World: TPC-D

and SAP R/3" by Doppelhammer et al. ("*Doppelhammer*").

By this Amendment, Applicants amend claims 1, 5, 8, 12, and 16, and cancel

claims 3, 4, 10, 15, and 19. The rejections of claims 3, 4, 10, 15, and 19 are thus

rendered moot.

Provisional Non-Statutory Obviousness-Type Double Patenting Rejection

Applicants respectfully traverse the provisional non-statutory obviousness-type

double patenting rejection of claims 1, 6, 7, 12, 14, 16, and 18, and request that the

rejection be held in abeyance. The '684 application is currently pending and, thus, no

double patenting circumstances can arise until a patent is granted. Since no patent has

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[1] The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

apparently issued from the '684 application, Applicants respectfully request that the provisional rejection be held in abeyance and any resolution in the form of a terminal disclaimer or otherwise be deferred.

Rejection of Claims 1, 5-8, 11, 12, 14, 16, and 18 under 35 U.S.C. § 102(e)

Applicants respectfully traverse the rejection of claims 1, 5-8, 11, 12, 14, 16, and 18 under 35 U.S.C. § 102(e) as being anticipated by *Gungabeesoon*. In order to properly establish that *Gungabeesoon* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *See* M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that *Gungabeesoon* fails to teach or suggest each and every element of Applicants' claims.

Independent claim 1, as amended, calls for a combination including, for example, "executing the run-time code in the second run-time environment . . . using the adapter to perform . . . input validation." *Gungabeesoon* does not teach or suggest at least this element of claim 1.

Gungabeesoon discloses a Publish-to-Web component "which acts as a . . . gateway for requests to . . . and replies from . . . a legacy application." *Gungabeesoon*, col. 10, lines 6-8. In *Gungabeesoon*, "the outbound data for display . . . are sent to . . . Publish-to-Web . . . [which] reformats the application data for publishing to the network."

Id., col. 9, lines 20-25. "User input data obtained from the network user agent 570 are also processed by the Publish-to-Web . . . and reformatted as application input data." *Id.*, col. 9, lines 28-31. Accordingly, *Gungabeesoon* discloses that the Publish-to-Web component, which the Examiner alleges is a teaching of the claimed "adapter," changes the format of the input and output data. However, the Publish-to-Web component of *Gungabeesoon* does not "perform . . . input validation," as recited in claim 1. Therefore, *Gungabeesoon* fails to teach or suggest "using the adapter to perform . . . input validation," as recited in claim 1.

Gungabeesoon discloses that "network pages are generated by converting the display file records 440 to JavaServer Pages 520 containing DHTML . . . with Cascading Style Sheets and JavaScript used by the client to perform local validation of input fields . . . to customize for a user's presentation style." *Id.*, col. 9, lines 2-7. However, the Cascading Style Sheets and JavaScript in *Gungabeesoon* validate input fields for style and presentation purposes, but do not validate the actual input data or values. Therefore, *Gungabeesoon* fails to teach or suggest "input validation," as recited in claim 1. Furthermore, even if *Gungabeesoon* teaches input validation, *Gungabeesoon* does not teach or suggest "using the adapter to perform . . . input validation," as recited in claim 1, for reasons discussed above.

For at least the foregoing reasons, *Gungabeesoon* does not to teach or suggest each and every element of claim 1. *Gungabeesoon* thus fails to anticipate claim 1. Furthermore, independent claims 8, 12, and 16, although different in scope from claim 1, have been amended to include recitations similar to those discussed above for

claim 1. Therefore, claims 8, 12, and 16 are allowable over *Gungabeesoon* for at least

reasons similar to those given for claim 1. In addition, dependent claims 5-7, 11, 14,

and 18 are allowable over *Gungabeesoon* at least by virtue of their dependence from

allowable base claims 1, 8, 12, and 16. Accordingly, Applicants respectfully request

that the Examiner reconsider and withdraw the rejection of claims 1, 5-8, 11, 12, 14, 16,

and 18 under 35 U.S.C. § 102(e).

Rejection of Claims 2, 9, 13, and 17 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 2, 9, 13, and 17 under

35 U.S.C. § 103(a) as being unpatentable over *Gungabeesoon* in view of

Doppelhammer. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation

of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections

on obviousness cannot be sustained with mere conclusory statements." M.P.E.P.

§ 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C.

103 . . . [includes] [a]scertaining the differences between the claimed invention and the

prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s)

between the prior art and the claimed invention would have been obvious to one of

ordinary skill in the art." M.P.E.P. § 2141(III).

A *prima facie* case of obviousness has not been established because the

Examiner has not properly ascertained the difference between the prior art and the

claimed invention, and thus has failed to clearly articulate a reason why the prior art

would have rendered the claimed invention obvious to one of ordinary skill in the art.

As discussed above, *Gungabeesoon* does not teach or suggest all the elements

of independent claims 1, 8, 12, and 16, and required by respective dependent claims 2,

9, 13, and 17. The Examiner cited *Doppelhammer* as a teaching of several elements of

claims 2, 9, 13, and 17 in support of this rejection. *See* Final Office Action, pp. 15-17.

Even assuming that the Examiner's characterization of *Doppelhammer* is correct, which

Applicants do not concede, *Doppelhammer* fails to cure the above-noted deficiencies of

Gungabeesoon. That is, *Doppelhammer* also does not teach or suggest "executing the

run-time code in the second run-time environment . . . using the adapter to perform . . .

input validation." Therefore, the prior art, taken individually or in proper combination,

fails to teach each and every element recited in independent claims 1, 8, 12, and 16,

and required by dependent claims 2, 9, 13, and 17. Accordingly, the Examiner has not

properly ascertained the difference between the prior art and Applicants' claims, and

thus the Examiner failed to clearly articulate a reason why the prior art would have

rendered claims 2, 9, 13, and 17 obvious to one of ordinary skill in the art. Therefore, a

prima facie case of obviousness has not been established, and Applicants respectfully

request that the Examiner reconsider and withdraw the rejection of claims 2, 9, 13, and

17 under 35 U.S.C. § 103(a).

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of this

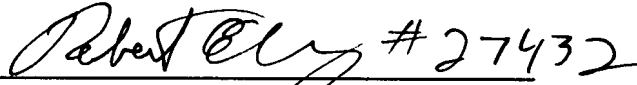application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge

any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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